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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,542	02/27/2004	Frederic Schoer	112843-63	7084

7590 06/03/2005

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EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/788,542

Applicant(s)

SCHEER ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/789,549. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending Application claims a blend containing the recited amounts of polylactic acid, poly(epsilon caprolactone), aliphatic polyester, and magnesium silicate, wherein the blend further containing the recited amount of peroxide, and articles and methods related to said blend.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 11-16, 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over CHEN ET AL (US 5,756,651),
in view of GRUBER ET AL (US 5,594,095).

CHEN '651 discloses polylactide-based compositions comprising polylactide, 3-40 wt % polycaprolactone, 5-20 wt% plasticizer (e.g., monocarboxylic esters such as adipate esters), and 0.5-10 wt% antiblocking agent (e.g., talc). The compositions are melt processable at typical temperatures of 180 C. (line 42-53, col. 3; line 60, col. 4 to line 5, col. 5; line 37, col. 5 to line 20, col. 6; line 12-20, col. 7; line 60-63, col. 8; line 44-50, col. 9) However, the reference fails to explicitly disclose laminates and the recited amounts of peroxide.

GRUBER ET AL '095 discloses that it is well known in the art to incorporate peroxides (e.g., dicumyl peroxide, dibenzoyl peroxide) into polylactide resins in typical ratios of 0.05/1 to 3/1 in order to improve the melt processibility of the resin. The reference also discloses that it is well known in the art to use polylactide resins and blends as a layer in a laminate (e.g., as a coating for paper). (line 24-31, col. 5; line 21-59, col. 15; line 15-24, col. 25; line 6-33, col. 28; line 59, col. 28 to line 34, col. 29; line 10-25, col. 31; Example 11, 13)

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the biodegradable polylactide compositions disclosed in CHEN '651 in well known disposable food service articles (e.g, plates, cups, etc) (claims 12, 22, 24, 27). It also would have been obvious to incorporate peroxides into the polylactide-based composition in order to improve melt processing characteristics.

5. Claims 7-10, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over CHEN ET AL (US 5,756,651), in view of GRUBER ET AL (US 5,594,095);

as applied to claims 1, 11 above, and further in view of GRUBER ET AL (US 5,773,562) and NAKATA ET AL (US 2002/0094444).

GRUBER ET AL '562 discloses that it is well known in the art to additional biodegradable polymers such as aliphatic polyesters in polylactide-based blends in typical amounts of 1-95 wt% in order to improve film properties (lines 20-50, col. 7).

NAKATA ET AL discloses that it is well known in the art to use adipic acid-containing aliphatic polyesters in biodegradable polylactide resin blends in order to form compostable disposable articles. (paragraphs 0142-0159)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate minor amounts of known aliphatic polyesters into the blends of CHEN ET AL '651 in order to tailor the mechanical properties and other physical properties for specific applications.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 31, 2005



Vivian Chen
Primary Examiner
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